BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **VIKTORS BERSTIS**	§ § §	Attorney Docket No. **AT9-99-725**
Serial No.: **09/466,438**	§ §	Examiner: **JAMES A. KRAMER**
Filed: **17 DECEMBER 1999**	§ §	
For: **METHOD AND SYSTEM FOR TRIGGERING ENHANCED SECURITY VERIFICATION IN RESPONSE TO ATYPICAL SELECTIONS AT A SERVICE-ORIENTED USER INTERFACE TERMINAL**	§ § § § § § §	Art Unit: **3627**

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Sir:

  This Reply Brief is submitted in answer to the Examiner's Answer mailed December 13, 2007.

ARGUMENTS

In its Decision on Appeal dated September 27, 2006 ("Decision"), the Board of Patent Appeals and Interferences ("Board") remanded the case to the Examiner "to determine whether prior art is available that would have fairly suggested to one skilled in the art to modify the *Findley* method to include the step of requiring the user to answer a security-related question if the option for goods and/or services by the user are inconsistent with the user's restored selections of goods and/or services". (Decision, p. 7). In the Appeal Brief dated September 7, 2007 ("Brief"), Appellant demonstrated that the rejection of Claims 1-4, 6, 8-9, 13-21, 23 and 25 under 35 U.S.C. §103(a) as being unpatentable over *Findley* in view of *French* should be reversed because Appellant's claimed invention is not obvious in view of the combination of *Findley* and *French*.

Appellant argued, for example, that the combination of *Findley* and *French* fails to render obvious the step of requiring the user to answer a security-related question if the options for goods and/or services selected by the user are inconsistent with the user's prestored selections of goods and/or services, as claimed in the Appellant's application. Taken in combination with *Findley, French* teaches that if a request to access a computer network includes a name and an associated social security number, a concurrent or later request with the same name but different social security number may be denied or flagged for further authentication (col. 6, line 58 to col. 7 line 5). The combination of *Findley* and *French* therefore differs from the Appellant's claimed invention in that an improper match between a name and social security number is what flags a transaction in *Findley/French*, not inconsistencies between a selection of goods and/or services and a prestored selection of goods and/or services, as claimed. Determining whether a name and social security number match each other does not teach or suggest comparing a selection of goods and/or services with a user's prestored selection of goods and/or services to prompt a security-related question.

In the Examiner's Answer dated December 13, 2007 ("Answer"), the Examiner responds to the foregoing by stating that Appellant has taken a narrow interpretation of the references rather than the claim language (Answer, p. 9, para. 10). However, the claim language clearly

states that inconsistencies in selections of "goods and/or services" with a user's pre-stored selections of "goods and/or services" is what triggers a security-related question. *French* teaches using an inconsistent match between a name and social security number to flag a request for computer network access for further authentication (*French*, col. 6, lines 62-67). There is no teaching or suggestion in *French* of comparing a selection of goods and/or services with a pre-stored selection of goods and/or services to prompt a security-related question, as claimed. Appellant respectfully submits that the Examiner is using an interpretation of the prior art that is unreasonably broad, specifically that an inconsistency between a selection of goods and/or services and a pre-stored selection of goods and/or services is suggested by an inconsistency a between a name and social security number. Therefore, the combination of *Findley* and *French* does not render obvious the step of requiring the user to answer a security-related question if the options for goods and/or services selected by the user are inconsistent with the user's prestored selections of goods and/or services, as claimed.

Also in the Answer, the Examiner states that the motivation to combine *Findley* and *French* is implied in the teaching of *Findley* whereby a thief will have different tastes and seek to purchase from different merchants to whom the stolen card number and the thief's origin will be new (Answer, p. 10, para. 10). However, the teaching in *Findley* cited by the Examiner is not the inconsistency of selected goods and/or services with pre-stored goods and/or services, as claimed, but an inconsistency between a credit card number and the origin of a purchase request. With regard to merchandise, *Findley* specifically teaches blocking a purchase request if an item within the same merchandise category has been previously purchased within a set time period (col. 4, lines 49-61). *Findley* teaches that, "By having a safe-guard such as that in block 118 the merchant limits its exposure to repetitive theft from the same merchandise category" (col 4, lines 58-61). By teaching a safe-guard that blocks an attempt to purchase goods and/or services that are consistent with a previous purchases, *Findley* teaches away from the claimed invention, which requires a security-related question to be answered if selected goods and/or services are inconsistent with a user's pre-stored selection of goods and/or services. Therefore, there is no motivation to combine *Findley* and *French* to achieve the claimed invention.

The Examiner "asserts that the inconsistent purchase of goods and services would be one of the expected criteria that *Findley* in view of *French et al.* would have sought to include within

Findley's 'history factors' so as to provide more accurate purchase request information based upon the differing 'tastes' of fraudulent users" (Answer, p. 10, para. 10). However, *Findley* specifically defines what comprises the "history factors" that are used to block purchase request. The history factors of *Findley* are defined as the origin of the purchase request (OHF), card number (CHF), dollar purchase amount (D), number of months since date of purchase, and no fraud indication purchases more than one month old (P). (col. 3, line 66 to col. 4, line 30). Neither *Findley* nor *French* teach of comparing goods and/or services with pre-stored selections of goods and/or services as a "history factor" for equations 1-3 of *Findley*. Therefore, Appellant respectfully disagrees with the Examiner that the inconsistent purchase of goods and/or services would be one of the expected criteria that the combination of *Findley* and *French* would have sought to include within *Findley's* "history factors".

Appellant contends, therefore, that *French* does not fairly suggest to one skilled in the art to modify the *Findley* method to include the step of requiring the user to answer a security-related question if the option for goods and/or services by the user are inconsistent with the user's restored selections of goods and/or services. Also in the Brief, Appellant demonstrated that the rejection of Claims 5, 10 and 22 under 35 under 35 U.S.C. §103(a) as being unpatentable over *Findley* in view of *French* in further view of *Penzias* should be reversed because Appellant's claimed invention is not obvious in view of the combination of *Findley*, *French* and *Penzias*. In the Answer, the Examiner raises no new arguments. Appellant reasserts the arguments put forth in the Brief regarding the improper rejection of Claims 5, 10 and 22. It is respectfully urged that all claims are in condition for allowance and favorable action is requested.

Respectfully submitted,

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